



[600.1177]

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Re: Application of: Kevin Lauren COTE, et al.
Serial No.: 10/005,660
Filed: November 2, 2001
For: LOW INERTIA ROLL
Art Unit: 3726
Examiner: JIMENEZ, MARC QUEMUEL

Mail Stop: APPEAL BRIEF - PATENTS
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

June 1, 2004

APPELLANTS' BRIEF UNDER 37 C.F.R. § 1.192

Sir:

Appellants submit this brief for the consideration of the Board of Patent Appeals and Interferences (the "Board") in support of their appeal of the Final Rejection dated August 29, 2003 in this application. An original and two copies of this brief are submitted herewith. The statutory fee of \$330.00 is paid concurrently herewith.

1. REAL PARTY IN INTEREST

The real party in interest is Heidelberger Druckmaschinen AG, a German corporation having a place of business at Kurfuersten-Anlage 52-60, D-69115 Heidelberg, Germany, the assignee of the entire right, title and interest in the above-identified patent application. The invention was assigned by inventors Cote and

Villeneuve to Heidelberger Druckmaschinen AG. The assignment was recorded on April 18, 2002 at reel 012864/ frame 0212.

2. RELATED APPEALS AND INTERFERENCES

Appellants, their legal representatives, and assignee are not aware of any appeal or interference that directly affects, will be directly affected by, or will have a bearing on the Board's decision in this appeal.

3. STATUS OF CLAIMS

Claims 1 to 16 and 21 to 24 are pending. Claims 1, 4 to 8, 23 and 24 have been finally rejected as per the Final Office Action dated August 29, 2003. Claims 2, 3, 9 to 16, 21 and 22 have been objected to as per the Final Office Action dated August 29, 2003. Claims 17 to 20 have been canceled.

The rejection to claims 1, 4 to 8, 23 and 24 and the objection to claims 2, 3, 9 to 16, 21 and 22 thus is appealed. A copy of appealed claims 1 to 16 and 21 to 24 is attached hereto as Appendix A.

4. STATUS OF AMENDMENTS AFTER FINAL

A Response to the Final Office Action was filed on December 1, 2003 and was entered by the Advisory Action of March 5, 2004. An amendment to claim 22 which is not on appeal was entered. No appealed claims were amended after final.

5. SUMMARY OF THE INVENTION

The present invention provides a method for making a roll for a rotary printing press, the method comprising: cutting a first strip of a first material (e.g., 1 in Fig. 1, see, e.g., specification paragraph [0025]) so as to form a first web (e.g., 3 in Fig. 1 or 15 in Fig. 2, see, e.g., specification paragraphs [0025] and [0032]) with a plurality of first tabs (e.g., 4 in Fig. 1 or 20 in Fig. 2, see, e.g., specification paragraph [0025] and [0032]) disposed one after the other and extending from the first web (e.g., 3 in Fig. 1 or 20 in Fig. 2, see, e.g., specification paragraph [0025] and [0032]); bending the plurality of first tabs (e.g., 4 in Fig. 1 or 20 in Fig. 2, see, e.g., specification paragraph

[0025] and [0032]) relative to the first web so as to form a first strut strip (e.g., 31 in Fig. 2, see, e.g., specification [0032]) having the first tabs (e.g., 4 in Fig. 1 or 20 in Fig. 2, see, e.g., specification paragraph [0025] and [0032]) extending from the first web at an angle relative to a surface (e.g., 14 in Fig. 1 or 22 in Fig. 3, see, e.g., specification paragraph [0025] and [0034]) of the first web; wrapping the first strut strip (e.g., 31 in Fig. 2, see, e.g., specification paragraph [0036]) about a cylindrical form (see mandrel 9, e.g., specification paragraph [0030]), the strut strip (e.g., 13 in Fig. 1 or 31 in Fig. 2, see, e.g., specification paragraph [0025] and [0036]) following a helical path (e.g., 7 in Fig. 1, see, e.g., specification paragraph [0025]) about the cylindrical form (see, e.g., specification paragraph [0030]); and wrapping a second strip of a second material about projecting ends (e.g., band 29 in Fig. 3, see, e.g., specification paragraph [0035]) of the plurality of first tabs (e.g., 20 in Fig. 3, see, e.g., specification paragraph [0033] to [0035]) so as to form a cylindrical outer wall (e.g., 37 in Fig. 4, see, e.g. specification paragraph [0035] where band 29 forms outer wall 37).

The method may further comprise wrapping a third strip (e.g., 23 in Fig. 3 and specification paragraph [0033] and [0034]) of a third material about the cylindrical form so as to form a substrate for the first web.

6. ISSUES

Whether claims 1, 7, 8 and 23 should be rejected under 35 U.S.C. § 103(a) as being unpatentable over Lloyd (U.S. Patent No. 5,031,694) in view of Engelberts (U.S. Patent No. 4,336,642), and whether claims 4 to 6 and 24 should be rejected under 35 U.S.C. § 103(a) as being unpatentable over Lloyd (U.S. Patent No. 5,031,694) in view of Engelberts (U.S. Patent No. 4,336,642) as applied to claim 1, and further in view of Wiedenmann et al. (U.S. Patent No. 3,789,786).

7. GROUPING OF CLAIMS

Since the claims do not stand or fall together, they may be grouped as follows:

GROUP I: Claims 1, 7, 8 and 23; and

GROUP II: Claims 4 to 6 and 24.

8. ARGUMENTS

GROUP I:

Claims 1, 7, 8 and 23 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Lloyd (U.S. Patent No. 5,031,694) in view of Engelberts (U.S. Patent No. 4,336,642).

Claim 1 recites a method for making a roll for a rotary printing press, the method comprising:

cutting a first strip of a first material so as to form a first web with a plurality of first tabs disposed one after the other and extending from the first web;

bending the plurality of first tabs relative to the first web so as to form a first strut strip having the first tabs extending from the first web at an angle relative to a surface of the first web;

wrapping the first strut strip about a cylindrical form, the strut strip following a helical path about the cylindrical form; and

wrapping a second strip of a second material about projecting ends of the plurality of first tabs so as to form a cylindrical outer wall.

Lloyd teaches a heat exchange device without a second strip of material.

Engelberts discloses forming a heat exchange surface using a stretched strip 33, which is spaced widely as it is wound.

Claim 1 recites “wrapping a second strip of a second material about projecting ends of the plurality of first tabs so as to form a cylindrical outer wall.”

Cylindrical outer wall 37 of one embodiment of the present invention can be seen in Fig. 4 (which is a cutaway view), and is made from the second strip of material, as described in the specification at [0009] and [0035], for example. For example, band 29 can be the outer wall 37 of formed composite roll 33.

The roll is usable for example in printing presses (see [0001]) and claim 1.

The helical strip 33 of Engelberts does not form a cylindrical outer wall, but rather forms a spaced helical strip.

“Cylindrical” is defined as “shaped like a cylinder.” The relevant dictionary definition of a cylinder is “a solid consisting of two parallel planes bounded by identical closed curves, usually circles, that are interconnected at every point by a set of parallel lines perpendicular to the planes” or an outer surface of such a solid. See <http://www.wordreference.com>, for example.

This definition is consistent with the shape of outer wall 37 shown in Fig. 4 of the present specification, i.e. a surface that has interconnected parallel lines between two parallel planes formed by closed curves. Moreover, a wall encloses a structure. The helical strip 33 of Engelberts is not a “cylindrical outer wall” as interpreted in light of the present specification.

Thus even if there were proper motivation to combine the teachings of Lloyd with Engelberts (and it is respectfully submitted that there is none), the combination would not meet the present claim limitation of a cylindrical outer wall.

Moreover, claim 1 recites a method for making a roll for a rotary printing press. The proposed combination with a helical raised outer surface would appear not to be able to function as a roll of a printing press.

Withdrawal of the 35 U.S.C. 103 rejections to claim 1 and its dependent claims is respectfully requested.

GROUP II:

Claims 4 to 6 and 24 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Lloyd (U.S. Patent No. 5,031,694) in view of Engelberts (U.S. Patent No. 4,336,642) as applied to claim 1, and further in view of Wiedenmann et al. (U.S. Patent No. 3,789,786). Claims 4 to 6 and 24 depend from claim 1 and it is respectfully submitted that they are patentable for the same reason discussed with respect to claim 1.

In addition, claim 24 for example recites “providing a third strip to contact the first web.”

Wiedenmann permits a ribbon to be wrapped around a heat transfer conduits.

However, the teaching of Wiedenman would not contact the first web of the Lloyd/Engelberts combination but would rather contact the tabs. There also seem to

be no reason or motivation in Widenmann to contact the first web of the
Lloyd/Engelberts combination.

Withdrawal of the rejection to claims 4 to 6 and 24 for this reason as well is
respectfully requested.

Respectfully submitted,

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APPENDIX A:

PENDING CLAIMS 1, 4 to 8, 23 and 24 OF U.S.
APPLICATION SERIAL NO. 10/005,660

Claim 1 (previously presented): A method for making a roll for a rotary printing press, the method comprising:

cutting a first strip of a first material so as to form a first web with a plurality of first tabs disposed one after the other and extending from the first web;

bending the plurality of first tabs relative to the first web so as to form a first strut strip having the first tabs extending from the first web at an angle relative to a surface of the first web;

wrapping the first strut strip about a cylindrical form, the strut strip following a helical path about the cylindrical form; and

wrapping a second strip of a second material about projecting ends of the plurality of first tabs so as to form a cylindrical outer wall.

Claim 4 (previously presented): The method as recited in claim 1 further comprising wrapping a third strip of a third material about the cylindrical form so as to form a substrate for the first web.

Claim 5 (original): The method as recited in claim 4 further comprising applying a layer of an adhesive to the substrate before the wrapping the first web.

Claim 6 (original): The method as recited in claim 4 wherein the substrate forms an inner wall of the roll.

Claim 7 (original): The method as recited in claim 1 wherein the first web forms an inner wall of the roll.

Claim 8 (previously presented): The method as recited in claim 1 wherein the second strip of material is wrapped so as to form the cylindrical outer wall disposed at a

distance from the wrapped first web, the plurality of first tabs extending between the wrapped first web and the wrapped second strip.

Claim 23 (previously presented): The method as recited in claim 1 wherein the second strip contacts the first tabs.

Claim 24 (previously presented): The method as recited in claim 23 further comprising providing a third strip to contact the first web.